

REMARKS

The foregoing amendment amends claims 3-5, 9-14 and 17-18, cancels claims 1-2, 6-8 and 15-16, and adds new claim 19. Now pending in the application are claims 3-5, 9-14 and 17-19, of which claims 3, 9, 14 and 17 are independent. The following comments address all stated grounds for rejection and place the presently pending claims, as identified above, in condition for allowance.

Patentable Subject Matter

Claims 14, 17 and 18 are indicated to recite patentable subject matter and would be allowable if rewritten in independent form. In the foregoing claim amendments, Applicants rewrite claims 14 and 17 in independent form by incorporating the limitations of the base claim and all of the intervening claims. No new matter is added. In light of the foregoing claim amendments, Applicants submit that claims 14, 17 and 18 are in condition for allowance.

Claim Amendments

Applicants amend claims 3-5, 9-14 and 16-18 to clarify the scope of the claimed invention. In particular, claim 3 is amended to incorporate the limitation of claims 1 and 2, which are now canceled. Claims 4 and 5 are amended to depend from claim 3. Also, claim 9 is amended to incorporate the limitations of claims 6, 7 and 8, which are now canceled. Claims 10 and 11 are amended to depend from claim 9. Applicants add claim 19 to rewrite claim 16 to depend from allowable claim 17. No new matter is added.

Objection to the Drawings

The drawings are objected to because they are informal. Applicants submitted formal drawings on February 6, 2004. The Examiner indicates in the Office Action Summary that the formal drawings submitted on February 6, 2004 were accepted. Applicants therefore request the Examiner to reconsider and withdraw the objection to the drawings.

Claim Rejections under 35 U.S.C. § 112

Claims 3-4, 8-10 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In the forgoing claim amendments, Applicants amend the claims to address the issues raised by the Examiner. In light of the foregoing claim amendments, Applicants request the Examiner to reconsider and withdraw the rejection of claims 3-4, 8-10 and 13 under 35 U.S.C. § 112, second paragraph, and pass the claims to allowance.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 6-7, 11-12 and 15-16 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,180,091 ("Ota"). Applicants respectfully traverse the rejection for the following reasons.

In the foregoing claim amendments, claim 3 is amended to incorporate the limitations recited in claims 1 and 2, and claims 1 and 2 are subsequently canceled. Also, claim 9 is amended to incorporate the limitations recited in claims 6-8, and claims 6-8 are subsequently canceled. Claim 11-12 are amended to depend from claim 9. Furthermore, allowable claim 17 is rewritten in independent form by incorporating the limitations recited in claim 15, and claim 15 is subsequently canceled. Claim 19 is added to rewrite claim 16 to depend from allowable claim 17, and claim 16 is subsequently canceled.

In light of the foregoing claim amendments, Applicants submit that the rejection of claims 1, 6-7, 11-12 and 15-16 under 35 U.S.C. § 102(b) is moot. Applicants therefore request the Examiner to reconsider and withdraw the rejection of claims 1, 6-7, 11-12 and 15-16 under 35 U.S.C. § 102(b), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 5 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,180,091 (“Ota”). Applicants respectfully traverse the rejection for the following reasons.

In the foregoing claim amendments, claim 5 is amended to depend from amended claim 3. Furthermore, claim 13 now depends from amended claim 9.

In light of the foregoing claim amendments, Applicants submit that the rejection of claims 5 and 13 under 35 U.S.C. § 103(a) is moot. Applicants therefore request the Examiner to reconsider and withdraw the rejection of claims 5 and 13 under 35 U.S.C. § 103(a), and pass the claims to allowance.

Claim Rejections - 35 U.S.C. § 103

Claims 2-4 and 8-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,180,091 (“Ota”) in view of U.S. Patent No. 5,927,585 (“Moorman”). Applicants respectfully traverse the rejection for the following reasons.

In the foregoing claim amendments, claim 3 is amended to incorporate the limitations recited in claims 1 and 2, and claims 1 and 2 are subsequently canceled. Claim 4 is amended to depend from claim 3. Also, claim 9 is amended to incorporate the limitations recited in claims 6-8, and claims 6-8 are subsequently canceled. Claim 10 is amended to depend from claim 9.

Applicants respectfully submit that the cited prior art references fail to teach or suggest all of the limitations of the claimed invention. Applicants submit that Ota and Moorman fail to teach that *the detection recess is disposed at a position, spaced in a direction opposite to the fastener driving direction, away from the head of the corresponding fastener having a longest available length accommodated by the magazine, when the end of the corresponding fastener fed into the fastener driving*

channel contacts a workpiece during the driving operation of the corresponding fastener through the fastener driving channel, as recited in amended claims 3 and 9.

Moorman is cited by the Examiner to provide teaching for the magazine recited in claims 2-4 and 8-10. Moorman teaches an electric powered multiple impact fastener driving tool having a magazine in which the magazine can be shifted within the guide block between an extended fastener starting position and a retracted fastener driven position. See Moorman, Abstract. In contrast, the claimed invention recites that the detection recess is disposed at a position, spaced in a direction opposite to the fastener driving direction, away from the head of the corresponding fastener having a longest available length accommodated by the magazine, when the end of the corresponding fastener fed into the fastener driving channel contacts a workpiece during the driving operation of the corresponding fastener through the fastener driving channel. With this structure, all of the ends of the fasters are positioned at the same reference point regardless of the length of the fasters. Moorman does not teach or suggest this structure of the claimed invention.

In light of the foregoing claim amendments and arguments, Applicants submit that Ota and Moorman fail to teach or suggest all of the limitations of amended claims 3 and 9. Claims 4 and 10, which depend upon claims 3 and 9, respectively, are not rendered obvious over the cited prior art references. Applicants therefore request the Examiner to reconsider and withdraw the rejection of claims 2-4 and 8-10 under 35 U.S.C. § 103(a), and pass the claims to allowance.

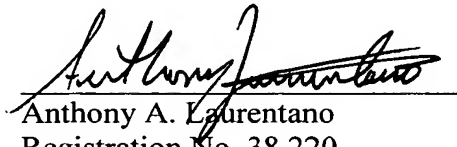
Conclusion

In view of above, Applicants believe that the pending application is in condition for allowance. If the above amendments are not deemed to place this case in condition for allowance, the Examiner is urged to call Applicant's representative at the telephone number listed below.

Date: **June 13, 2005**

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

A handwritten signature in black ink, appearing to read "Anthony A. Laurentano", is written over a horizontal line.

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